



DM-6999A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:

CASE NO.: DM-6999A

RAJOPADHYE, ET AL.

APPLICATION NO.: 09/599,890

GROUP ART UNIT: 1624

FILED: JUNE 21, 2000

EXAMINER: BALASUBRAMANIAN

FOR: VITRONECTIN RECEPTOR ANTAGONIST PHARMACEUTICALS

WILMINGTON, DELAWARE

FEBRUARY 7, 2002

#13
RECEIVED
FEB 19 2002
TECH CENTER 1600/2900

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
APPLICATION ABANDONED UNINTENTIONALLY UNDER 37 C.F.R. §
1.137(b)

Assistant Commissioner for Patents
Washington, D.C. 20231

ATTENTION: Petition Information
Crystal Park One, Suite 520

Applicants respectfully submit a petition for revival of the above-referenced patent application under 37 C.F.R. § 1.137(b) in response to Notice of Abandonment mailed October 17, 2001. Also, Applicants submit that the entire delay in filing the required reply from the due date for the reply until the filing of the grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

1. This application became unintentionally abandoned as a result of the following circumstances:
 - i) Applicants received an Office Action mailed April 4, 2001, wherein a restriction under 35 USC 121 was raised. A copy of the Office Action is enclosed.
 - ii) A Continued Patent Application (CPA) under 37 CFR 1.53(d) was filed September 7, 2001 on this application and a petition for an extension of time was timely filed on October 1, 2001. A copy of the CPA and extension of time are enclosed.

- iii) An Office Action, mailed September 21, 2001, was received by the Applicant October 1, 2001. This Office Action stated that request for the CPA was treated as a RCE because the CPA practice was no longer applicable. However, although the RCE was not applicable to this application, the Examiner failed to check one of the boxes 1-7 to indicate why an RCE was not applicable or what the status of the application was. As a result, Applicants application went abandoned. A copy of the Office Action is enclosed.
 - iv) Applicants received, on October 29, 2001, a Notice of Abandonment dated October 17, 2001, indicating the Application went abandoned for failing to respond to the Office Action mailed April 4, 2001. A copy of the a Notice of Abandonment is enclosed.
- 2. In view of the aforesaid, Applicants respectfully submit that this application became unintentionally abandoned.
 - 3. In view of 37 CFR §1.181(f) applicants submit a terminal disclaimer.
 - 4. Please charge a fee of \$1280.00 under 37 C.F.R. § 1.17(m) and a fee of \$110 under 37 C.F.R. § 120(d), any additional fees, or credit any overpayment, to Deposit Account No. 023850.
 - 5. Two extra copies of this Petition are enclosed for accounting purposes.
 - 6. Acknowledgement of the active status of the above-identified application is respectfully requested.

7. Applicants also submit herewith a response to the Office Action mailed April 4, 2001.

Respectfully submitted,



Peter L. Dolan, Ph.D.

Agent for Applicant

Registration No. 46,307

Phone: 302-695-7776

Bristol-Myers Squibb Pharma Company
Patent Department
P.O. Box 4000,
Princeton, New Jersey 08543-4000.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

FEE TRANSMITTAL
for FY 2001

FEB 08 2002

Patent fees are subject to annual revision.

AMOUNT OF PAYMENT (\$) 1178.00

Complete if Known

| | |
|----------------------|--------------------|
| Application Number | 09/599,890 |
| Filing Date | June 21, 2000 |
| First Named Inventor | Rajopadhye et al. |
| Examiner Name | V. Balasubramanian |
| Group / Art Unit | 1624 |
| Attorney Docket No. | DM-6999-A |

TECH CENTER 1600/2000

FEB 19 2002

RECEIVED

METHOD OF PAYMENT (check one)

1. ☒ The Commissioner is hereby authorized to charge indicated fees and credit any over payments to:Deposit
Account
Number

04-1928

Deposit
Account
NameDuPont Pharmaceuticals
Company

- ☒ Charge Any Additional Fee Required
Under 37 CFR 1.16 and 1.17
- ☐ Applicant claims small entity status.
See 37 CFR 1.27

2. ☐ Payment Enclosed:
☐ Check ☐ Credit card ☐ Money
Order ☐ Other

FEE CALCULATION

1. BASIC FILING FEE

| Large Fee Code | Entity Fee (\$) | Small Fee Code | Entity Fee (\$) | Fee Description | Fee Paid |
|-------------------|--------------------|-------------------|--------------------|------------------------|----------|
| 101 | 710 | 201 | 355 | Utility filing fee | 710.00 |
| 106 | 320 | 206 | 160 | Design filing fee | |
| 107 | 490 | 207 | 245 | Plant filing fee | |
| 108 | 710 | 208 | 355 | Reissue filing fee | |
| 114 | 150 | 214 | 75 | Provisional filing fee | |

SUBTOTAL (1)

(\$710.00)

2. EXTRA CLAIM FEES

| Total Claims | Extra Claims | Fee from below | Fee Paid |
|--------------------|-----------------|-------------------|-------------|
| 46 | 26 | 18 | 468 |
| Independent Claims | 0 | | 0 |
| Multiple Dependent | | | 468 |

| Large Fee Code | Entity Fee (\$) | Small Fee Code | Entity Fee (\$) | Fee Description |
|-------------------|--------------------|-------------------|--------------------|--|
| 103 | 18 | 203 | 9 | Claims in excess of 20 |
| 102 | 80 | 202 | 40 | Independent claims in excess of 3 |
| 104 | 270 | 204 | 135 | Multiple dependent claim, if not paid |
| 109 | 80 | 209 | 40 | ** Reissue independent claims over original patent |
| 110 | 18 | 210 | 9 | ** Reissue claims in excess of 20 and over original patent |

SUBTOTAL (2)

(\$1178.00)

FEE CALCULATION (continued)

3. ADDITIONAL FEES

| Large Fee Code | Entity Fee (\$) | Small Fee Code | Entity Fee (\$) | Fee Description | Fee Paid |
|-------------------|--------------------|-------------------|--------------------|--|----------|
| 105 | 130 | 205 | 65 | Surcharge - late filing fee or oath | |
| 127 | 50 | 227 | 25 | Surcharge - late provisional filing fee or cover sheet | |
| 139 | 130 | 139 | 130 | Non-English specification | |
| 147 | 2,520 | 147 | 2,520 | For filing a request for ex parte reexamination | |
| 112 | 920* | 112 | 920* | Requesting publication of SIR prior to Examiner action | |
| 113 | 1,840* | 113 | 1,840* | Requesting publication of SIR after Examiner action | |
| 115 | 110 | 215 | 55 | Extension for reply within first month | |
| 116 | 390 | 216 | 195 | Extension for reply within second month | |
| 117 | 890 | 217 | 445 | Extension for reply within third month | |
| 118 | 1,390 | 218 | 695 | Extension for reply within fourth month | |
| 128 | 1,890 | 228 | 945 | Extension for reply within fifth month | |
| 119 | 310 | 219 | 155 | Notice of Appeal | |
| 120 | 310 | 220 | 155 | Filing a brief in support of an appeal | |
| 121 | 270 | 221 | 135 | Request for oral hearing | |
| 138 | 1,510 | 138 | 1,510 | Petition to institute a public use proceeding | |
| 140 | 110 | 240 | 55 | Petition to revive - unavoidable | |
| 141 | 1,240 | 241 | 620 | Petition to revive - unintentional | |
| 142 | 1,240 | 242 | 620 | Utility issue fee (or reissue) | |
| 143 | 440 | 243 | 220 | Design issue fee | |
| 144 | 600 | 244 | 300 | Plant issue fee | |
| 122 | 130 | 122 | 130 | Petitions to the Commissioner | |
| 123 | 130 | 123 | 50 | Petitions related to provisional applications | |
| 126 | 240 | 126 | 240 | Submission of Information Disclosure Stmt | |
| 581 | 40 | 581 | 40 | Recording each patent assignment per property (times number of properties) | |
| 146 | 710 | 246 | 355 | Filing a submission after final rejection (37 CFR § 1.129(a)) | |
| 149 | 710 | 249 | 355 | For each additional invention to be examined (37 CFR § 1.129(b)) | |
| 179 (RCE) | 710 | 279 | 355 | Request for Continued Examination | |
| 169 | 900 | 169 | 900 | Request for expedited examination of a design application | |

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$0)

**or number previously paid, if greater; For Reissues, see above

SUBMITTED BY

Complete (if applicable)

Name (Print/Type)

Peter L. Dolan

Registration No. Attorney/Agent

46,307

Telephone

302-992-4528

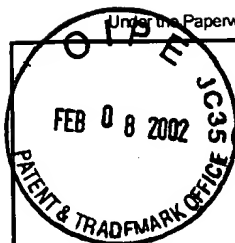
Signature

Date

September 7, 2001

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

**Certificate of Transmission under 37 CFR 1.8**

I hereby certify that this correspondence is being facsimile transmitted
to the Patent and Trademark Office

on October 1, 2001
Date

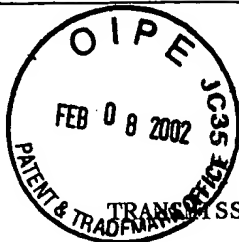
Ellen M. Godfrey
Signature

ELLEN M. GODFREY
Type or printed name of person signing Certificate

Note: Each paper must have its own certificate of transmission, or this certificate must
identify each submitted paper.

Petition for Extension of Time Under 37 CFR 1.136(a) for Serial No. 09/599,890
Fee Transmittal for Serial No. 09,599,89077
OUR DOCKET NO. DM-6999-A

ATTENTION: EXAMINER V. Balasubramanian
FACSIMILE: 703-308-2742



*** TX REPORT ***

TRANSMISSION OK

| | |
|----------------|--------------|
| TX/RX NO | 3517 |
| CONNECTION TEL | 817033082742 |
| SUBADDRESS | |
| CONNECTION ID | TC 1600 |
| ST. TIME | 10/01 14:27 |
| USAGE T | 02' 12 |
| PGS. | 3 |
| RESULT | OK |

PTO/SB/97 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted
to the Patent and Trademark Office

on October 1, 2001
Date

Ellen M. Godfrey
Signature

ELLEN M. GODFREY

Type or printed name of person signing Certificate

Note: Each paper must have its own certificate of transmission, or this certificate must
identify each submitted paper.

P tition for Extension of Time Under 37 CFR 1.136(a) for Serial No. 09/599,890
Fee Transmittal for Seial No. 09,599,89077
OUR DOCKET NO. DM-6999-A



DM-6999A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:

CASE NO.: DM-6999A

RAJOPADHYE, ET AL.

APPLICATION NO.: 09/599,890

GROUP ART UNIT: 1624

FILED: JUNE 21, 2000

EXAMINER: BALASUBRAMANIAN

FOR: VITRONECTIN RECEPTOR ANTAGONIST PHARMACEUTICALS

WILMINGTON, DELAWARE

October 1, 2001

Petition for Extension of Time Under 37 CFR §1.136(a)

Hon. Assistant Commissioner for Patents

Washington, D.C. 20231

Sir:

Applicant(s) hereby petitions for an extension of time under 37 CFR 1.136(a) in the above-identified application for five (5) months to maintain pendency of this application for the Continued Prosecution Application (CPA) filed September 7, 2001.

Please charge the associated fee of \$1,960 pursuant to 37 CFR 1.17 to Deposit Account No. 04-1928. If this amount is in error, please debit or credit Deposit Account No. 04-1928.

If more time or any fee is needed to file the accompanying paper(s), please consider this a petition for such time and an authorization to debit Deposit Account No. 04-1928 for any required fee.

02/10/2003 CSTYLES 00000001 041928 09599890
01 FC:1255 1960.00 CR

Respectfully submitted,

Dated: October 1, 2001

Peter L. Dolan, Ph.D.
Agent for Applicants
Registration No. 46,307

Adjustment date: 05/14/2003 PSTANBAC
02/10/2003 CSTYLES 00000001 041928 09599890
01 FC:1255 1960.00 CR



UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 09/599,890 | 06/21/00 | RAJUPADHYE | LR-6997-A |

PLD
NM11/0921
DUPONT PHARMACEUTICALS COMPANY
E I DUPONT DE NEMOURS AND COMPANY
LEGAL PATENTS
1007 MARKET STREET
WILMINGTON DE 19898

EXAMINER
BALASUBRAMANIAN, V

ART UNIT
1624

PAPER NUMBER

DATE MAILED: 09/21/01

RECEIVED

OCT 01 2001

Please find below and/or attached an Office communication concerning this application or proceeding.

PATENT RECORDS
CENTER

Commissioner of Patents and Trademarks

DOCKETED: 10/20/01
Due Date:
No Action Required:



Washington, D.C. 20231

www.uspto.gov

APPLICATION NUMBER FILE DATE FIRST NAMED APPLICANT ATTY DOCKET NO./TITLE

03/599,890 06/21/00 RAJOPADHYE M DM-6999-A

DUPONT PHARMACEUTICALS COMPANY
E I DUPONT DE NEMOURS AND COMPANY
LEGAL PATENTS
1007 MARKET STREET
WILMINGTON, DELAWARE 19801

BALASUBRAMANIAN, V

DATE MAILED:

1007 MARKET STREET
WILMINGTON, DE 19808

The request for continued examination (RCE) under 37 CFR 1.114 filed on 09/21/01 is improper for reason(s) indicated below:

- ☐ 1. Continued examination under 37 CFR 1.114 does not apply to an application for a design patent. Applicant may wish to consider filing a continuing application under 37 CFR 1.53(b) or a CPA under 37 CFR 1.53(d).
- ☐ 2. Continued examination under 37 CFR 1.114 does not apply to an application that was filed before June 8, 1995. Applicant may wish to consider filing a continuing application under 37 CFR 1.53(b) or a CPA under 37 CFR 1.53(d).
- ☐ 3. Continued examination under 37 CFR 1.114 does not apply to an application unless prosecution in the application is closed. If the RCE was accompanied by a reply to a non-final Office action, the reply will be entered and considered under 37 CFR 1.111. If the RCE was not accompanied by a reply, the time period set forth in the last Office action continues to run from the mailing date of that action.
- ☐ 4. The request was not filed before payment of the issue fee, and no petition under 37 CFR 1.313 was granted. If this application has not yet issued as a patent, applicant may wish to consider filing either a petition under 37 CFR 1.313 to withdraw this application from issue, or a continuing application under 37 CFR 1.53(b).
- ☐ 5. The request was not filed before abandonment of the application. The application was abandoned, or proceedings terminated on _____. Applicant may wish to consider filing a petition under 37 CFR 1.137 to revive this abandoned application.
- ☐ 6. The request was not accompanied by the fee set forth in 37 CFR 1.17(e) as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice.
- ☐ 7. The request was not accompanied by a submission as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice.

Note: If a request for a continued prosecution application (CPA) under 37 CFR 1.53(d) has been filed in the utility or plant application (including a previously filed CPA) that was filed on or after May 29, 2000, the request for a CPA has been treated as a RCE because the CPA practice no longer applies to such application. The constructive RCE, however, is improper for reason(s) indicated above.

A copy of this notice **MUST** be returned with any reply.

Direct the reply and any questions about this notice to:

_____, Examining Group _____



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| | | | |
|-----------------|-------------|----------------------|---------------------|
| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|

09/599,890 06/21/00 RAJOPADHYE

M DM-6999-4

| |
|----------|
| EXAMINER |
|----------|

HM12/1017
DUPONT PHARMACEUTICALS COMPANY
E I DUPONT DE NEMOURS AND COMPANY
LEGAL PATENTS
1007 MARKET STREET
WILMINGTON DE 19898

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1624 12
DATE MAILED: 10/17/01

RECEIVED

OCT 22 2001

PATENT RECORDS
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

| | |
|-----------------|-------|
| RECEIVED | |
| U.S. Patent Law | |
| OCT 29 2001 | |
| Docketed Item | _____ |
| Due Date | _____ |
| Attorney | PLD |

DOCKETED: 11/2/01
Due Date: _____
No Action Required: dmb

DOCKETED: 10/31/01
Due Date: _____
No Action Required: dmb

DOCKETED: 11-15-01
Due Date: abd.
No Action Required: dcp

Spokes w/peter
will receive

Notice of Abandonment

Applicati n No.

09/599,890

Examiner

Venkataraman
Balasubrasubramanian

Applicant(s)

RAJOPADHYE ET AL.


Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 04 April 2001.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance.
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file new formal drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed new formal drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ The proposed new formal drawings filed on _____ are not acceptable and the period for reply has expired.
 - (c) ☐ No proposed new formal drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:



JOHN M. FORD
PRIMARY EXAMINER
GROUP - ART UNIT 1624

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

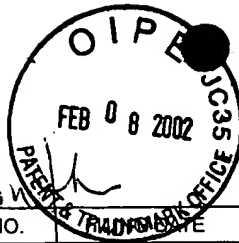
2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| | | |
|-----------------|----------------------|---------------------|
| APPLICATION NO. | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|----------------------|---------------------|

09/599,890

06/21/00

RAJOPADHYE

N

DM-6999-A

EXAMINER

HM12/0404

DUPONT PHARMACEUTICALS COMPANY
E I DUPONT DE NEMOURS AND COMPANY
LEGAL PATENTS
1007 MARKET STREET
WILMINGTON DE 19898

BALASUBRAMANIAN, V

ART UNIT

PAPER NUMBER

RECEIVED

APR 9 2001

DATE MAILED:

1624

04/04/01

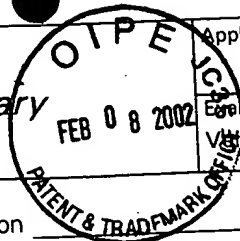
LSC NOTED
PATENT RECORDS
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

DOCKETED: 4-9-01
Due Date: 5-4-01
No Action Required: *dy*

Office Action Summary



Application No.
09/599,890

Applicant(s)

Rajophadye et al.

Examiner
Venkataraman Balasubramanian

Group Art Unit
1624



☐ Responsive to communication(s) filed on _____

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-75 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-75 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT B)

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s).

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OF



Application/Control Number: 09/599,890

Page 2

Art Unit: 1624

DETAILED ACTION

Claims 1-75 are pending.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6 and 42-46, drawn to compound bearing indazole nonpeptide Ia or Ib as targeting moiety not bound to surfactant or bound to a surfactant wherein X^{1d} , X^{2d} , X^{3d} , X^{4d} , are all carbon and a chelator, classified in class 548, subclass 361.1 and various other classes and subclasses depending upon the preferred embodiments of chelating group and other hetero ring substituents.
- II. Claims 1-6 and 42-46, drawn to compound bearing indazole nonpeptide Ia or Ib as targeting moiety not bound to surfactant or bound to a surfactant wherein X^{1d} , X^{2d} , X^{3d} , X^{4d} , are nitrogens and carbons and a chelator not provided for in invention I, classified in class 546, subclass 119, class 544, subclass 238, class 544, subclass 262, class 544, subclass 405, class 544, subclasses 180, 182, and various other classes and subclasses depending upon the preferred embodiments of chelating group and other hetero ring substituents.
- III. Claims 1-6 and 42-46, drawn to compound bearing indazole nonpeptide Q is any one of the two peptide recited in claim 2 as targeting moiety not bound to surfactant or bound to a surfactant and a chelator, classified in classes various subclasses various

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depending upon the preferred embodiments of chelating group and other hetero ring substituents.

- IV. Claims 7-10 and 58-64, drawn to a kit comprising compound bearing indazole nonpeptide Q, with or without chemotherapeutic agents, and radiosensitizer, classified in class 206, subclass 569 and others upon the preferred embodiments of Q, other hetero rings, chelating group and structural make-up of chemotherapeutic agents and radiosensitizer.
- V. Claims 11-30, 47-49, 56-57 and 65-67, drawn to multiple compositions, classified in class 514, subclass 221, class 514 subclasses various depending upon the preferred embodiment of chelator group, diagnostic or therapeutic or radiopharmaceutical or X-ray contrast agent (eg. class 424, subclass 9.4, 9.5, 9.51 etc).
- VI. Claims 31-42, 50-55 and 68-74 drawn to multiple method of use of compound bearing indazole nonpeptide Q, with or without chemotherapeutic agents, and radiosensitizer classified in class 514, subclass 221, class 514 subclasses various depending upon the preferred embodiment of chelator group, other variables hetero rings, structural make-up of chemotherapeutic agent and radiosensitizer.
- VII. Claim 75 drawn to a process for preparation of diagnostic or therapeutic metallopharmaceutical classified in class 514, and others subclasses various depending upon the preferred embodiment of targeting moiety and chelator which are not structurally defined in the claim.

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If any one of the invention I-III is elected, applicants should elect a suitable chelating group and working example for examination of elected invention. In addition, applicant may elect a specific composition and a specific method of use for a specific disease form inventions V and VI respectively.

If invention IV (ie. kit) is elected applicant should elect any one of the targeting moiety as in invention I-III and chelating group, an appropriate chemotherapeutic agent/ radiosensitizer if applicable and working example for examination of elected invention.

If invention V is elected, applicants should elect any one of the targeting moiety as in groups I-III and chelating group, a specific intended use as recited in invention and working example for examination of elected invention.

If invention VI is elected, applicants should elect i) a specific metal, ii) a specific chelator group and iii) a specific target moiety, namely, indazole nonpeptide, with working example and iv) a specific disease for examination of the elected invention.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are independent and distinct from each other because they are directed to structurally dissimilar compounds that lack common core namely indazole vs isomeric pyridinopyrazoles vs isomeric pyridazinopyrazoles vs isomeric pyrimidinopyrazoles versus pyrazinopyrazole vs isomeric triazinylpyrazoles vs tetrazinylpyrazole. Consequently, the inventions have different classifications and require separate prior art searches. They can be made and used independently. Art which may render obvious or anticipate one of the groups would not necessarily

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do the same for the other group. Each can support a patent as the compounds of each group are capable of being utilized alone not in combination with other members listed in the Markush group.

Search of these class of compounds with variants permitted would pose a serious burden.

Inventions I-III and IV are related as product and process of use of the product as kit.

They are distinct from each other as there is no required combination. The kit can be used independently. Prior art which anticipates or renders inventions I-III obvious may not be applicable to the kit. The issues of patentability of kit such as 112 issues and enablement may not be applicable to compounds of Inventions I-III.

Inventions I-III and V are related as product and multiple composition for different intended use of the composition. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the composition for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different composition of using that product (MPEP § 806.05(h)). In the instant case, the compound of claim 1 can be used as therapeutic radiopharmaceutical for cancer, arthritis etc as well as SPECT or PET diagnostic agents or ultra sound contrast agents as evidenced by applicants claims. Similarly, it is clear from the claims that the process of using can be practiced with materially different products containing a non radioactive material as well as radioactive metals.

Similarly the ultrasound contrast agents, invention XIII is independent and distinct

Inventions I-III and VI are related as product and multiple method of use The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using

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the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the compound of claim 1 can be used as therapeutic radiopharmaceutical for cancer, arthritis etc as well as SPECT or PET diagnostic agents or ultra sound contrast agents as evidenced by applicants claims. Similarly, it is clear from the claims that the process of using can be practiced with materially different products containing a non radioactive material as well as radioactive metals.

Inventions V and VII are related as multiple pharmaceutical composition (product) and process of making them . The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for making the product as claimed can be practiced with another materially different product or (2) the product as claimed can be made by a materially different process (MPEP § 806.05(h)). In the instant case as noted above each of the pharmaceutical composition is distinct from one another and hence the process of making the composition is patentably distinct. Furthermore, scope of the claim 75 is broader than the composition claim and hence would raise different issues of patentability.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious

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variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Due to the distinct nature of the inventions a restriction is set forth in writing.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on weekdays from 8.30 AM to 5.00 PM.

The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

703-308-2742
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VB

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3/26/2001

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